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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,293	06/27/2003	Matthew James Callow	CAL-1CIP	9024
34285	7590	11/13/2006	EXAMINER	
NUVELO, INC 201 INDUSTRIAL ROAD SUITE 310 SAN CARLOS, CA 94070			CALAMITA, HEATHER	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/608,293	Applicant(s) CALLOW ET AL.	
	Examiner Heather G. Calamita, Ph.D.	Art Unit 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/22/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 18-21 (Group II) in the reply filed on May 15, 2006 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichikawa et al. (PNAS 2000).

With regard to claim 18, Ichikawa et al. teach two sets of universal building blocks comprising:

a) a first set of single-stranded oligonucleotides having a first end and a second end, said first end having a sticky-end overhang and said second end having sequence of 8-20 bases; and

b) a second set of single-stranded oligonucleotides having a first end and a second end, said first end having a sticky-end overhang and said second end having a sequence of 8-20 bases, wherein said first ends of said first and second sets are different, and said second end of said first set are complementary to said second end of said second set, generating all possible combinations of adapter sequences (see p. 9660 col. 2 under RT-PCR analysis line 4, where Ichikawa et al teach random decamers. The random decamers necessarily encompass the instantly claimed oligonucleotide sets. Here the random decamers comprise ALL POSSIBLE 10mers this set of 10mers, comprising 4^{10} different sequences, will necessarily have oligonucleotides found within the instantly claimed sets. Admittedly, there will also be 10mers present in the set which do not meet the structural limitations of the instantly

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claimed oligos but Applicant uses the language of comprising so the reference is allowed to encompass these additional elements).

With regard to claim 19, Ichikawa et al. teach the sets of universal building blocks of claim 18, wherein said first and second set are comprised of up to 64 different first end 3-base overhangs (see p. 9660 col. 2 under RT-PCR analysis line 4, where Ichikawa et al teach random decamers. The random decamers necessarily encompass the instantly claimed oligonucleotide sets. All possible 10mers will necessarily comprise all possible overhangs, for example all possible 1 base overhangs, 2 base overhangs 3 base overhangs, 4 base overhangs and 5 base overhangs).

With regard to claim 20, Ichikawa et al. teach the sets of universal building blocks of claim 18, wherein said first and second set are comprised of up to 256 different first end 4-base overhangs (see p. 9660 col. 2 under RT-PCR analysis line 4, where Ichikawa et al teach random decamers. The random decamers necessarily encompass the instantly claimed oligonucleotide sets).

With regard to claim 21, Ichikawa et al. teach the sets of universal building blocks of claim 18, wherein said first and second set are comprised of up to 1024 different first end 5-base overhangs (see p. 9660 col. 2 under RT-PCR analysis line 4, where Ichikawa et al teach random decamers. The random decamers necessarily encompass the instantly claimed oligonucleotide sets).

Summary

3. No claims were allowed.

Correspondence

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather G. Calamita whose telephone number is 571.272.2876 and whose e-mail address is heather.calamita@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route. The examiner can normally be reached on Monday through Thursday, 7:00 AM to 5:30 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at 571.272.0782.

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Papers related to this application may be faxed to Group 1637 via the PTO Fax Center using the fax number 571.273.8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to 571.272.0547.

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hgc



JEFFREY FREDMAN
PRIMARY EXAMINER

